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In re the U.S. Application of

Michael F. QUINN et al.

Group Art Unit: 2761

MAR 08 1999

U.S. Serial No. 08/626,600

Group 2700

Filed: April 2, 1996

Examiner: Hugnet, W.

For: DOCUMENT STORAGE AND RETRIEVAL SYSTEM (As Amended)

Box DAC

Assistant Commissioner For Patents

Washington, D.C. 20231

PETITION TO REOPEN PROSECUTION PURSUANT TO 37 C.F.R. § 1.181(a)

Sir,

Appellant respectfully requests the Commissioner to reopen prosecution of the present application to allow appellant an opportunity to respond to the new grounds of rejection raised by the examiner in the examiner's answer pursuant to 37 C.F.R. §§ 1.193(a)(2) and 1.181(a). Upon granting this petition, appellant will supply an amendment pursuant to 37 C.F.R. §§ 1.111 or 1.113 in accordance with 37 C.F.R. § 1.193(b)(2)(i).

In addition to this petition, Appellant submits the attached brief in support of the petition. Appellant believes no petition fee is required pursuant to 37 C.F.R. § 1.17. The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account 11-085. A duplicate copy of this letter is enclosed for that purpose.

Respectfully submitted,

Michael F. QUINN et al.

Date: 3/4/99

By:

George T. Marcou

Registration No. 33,014

KILPATRICK STOCKTON LLP
Suite 800
700 13th Street, N.W.
Washington, D.C. 20005
(202) 508-5800

KILPATRICK STOCKTON LLP

CERTIFICATE OF RECEIPT & TRANSMISSION
I hereby certify that the foregoing communication was transmitted to the United States Patent and Trademark Office, Washington, D.C. 20231.

On March 4, 1999

KILPATRICK STOCKTON LLP
700 13th Street, N.W., Suite 800
Washington, D.C. 20005

By: George T. Marcou

Date: March 4, 1999

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For: DOCUMENT STORAGE AND RETRIEVAL SYSTEM (As Amended)

Box DAC
Assistant Commissioner For Patents
Washington, D.C. 20231**BRIEF IN SUPPORT OF PETITION TO REOPEN PROSECUTION**

On January 4, 1999, the Examiner issued an Examiner's Answer in response to appellant's Appeal Brief filed on November 25, 1998. A copy of the Appeal Brief is attached as exhibit 1 and a copy of the Examiner's Answer is attached as exhibit 2. The Examiner's Answer contains a new ground of rejection in contravention of 37 C.F.R. § 1.193(a)(2). Appellant respectfully requests that the petition to reopen prosecution be granted for the reasons contained in this brief.

Basis For Petition

37 C.F.R. § 1.193 (a)(2) provides that "[a]n examiner's answer must not include a new ground of rejection" unless Appellant was advised of the new rejection via the Examiner informing Appellant that a previously 37 C.F.R. § 1.116 amendment would be entered for the purposes of appeal but would not place all claims in condition for allowance. In that situation, the Appellant is deemed to have been given fair notice of the new rejection. Appellant respectfully asserts that the Examiner raised a new

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ground of rejection in the Examiner's Answer that was not precipitated by an amendment under 37

C.F.R. § 1.116.

Facts Supporting The Petition

On pages 6-7 of the final rejection, the Examiner asserts

As regards the Examiner's alleged contradiction regarding storage of customer's messages, the Examiner asserts, as stated at paragraph 14(A) of the prior office action, that Cukor discloses means for storing messages and inquiries at Col. 21, line 13 - Col. 22, line 1. However, Claim 1 recites such storage means to be part of "customer service units". Furthermore, the Specification identified the messages as being originated and accessed by users (customers) (Specification at page 22, line 21 - page 24, line 14). Therefore, while Cukor failed to expressly teach that the messages and inquiries being stored were customer messages and inquiries, the Examiner asserted that it would have been obvious to one of ordinary skill in the art of financial information management to include means for storing customer messages and inquiries. One would be so motivated to do so in order to retain all information related to a particular transaction in a single, searchable database for subsequent review and/or retrieval and to avoid the problems associated with handling paper documents. This motivation comes directly from the Cukor reference at Col. 1, line 65 - Col. 2, line 21; Col. 3, lines 19-30; Col. 3, line 56 - Col. 4, line 19. (emphasis in original).

This is a new ground of rejection for several reasons. First, the Examiner has changed his position regarding what Cukor teaches from the Final Rejection to the Examiner's Answer. On page 6 of the Final Rejection the Examiner stated that "it would have been obvious to one of ordinary skill in the art of financial information management to include means for storing customer messages and inquiries." On page 8 of the Examiner's Answer, the Examiner shifts his position by stating Cukor expressly teaches these limitations by asserting "Cukor discloses . . . (3) messages at Col. 21, lines 13-20; and (4) completed inquiries at Col. 21, lines 15-27."

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Typical cases involving new grounds of rejection involve either the Board of Patent Appeals and Interferences using a different statutory basis to form a rejection than the primary examiner or a primary examiner using a different statutory basis in different office actions. This case is very similar to those instances. More particularly, what is of interest in this case is the fact that references are used to teach or show as obvious specific limitations within claims. If a single reference teaches all limitations, it is considered to be a 35 U.S.C. § 102 reference. If a combination of two or more references teaches all of the limitations of a claim, they are considered to be 35 U.S.C. § 103 references. In the case of using references under 35 U.S.C. § 103, it is necessary for the Examiner to state what the primary reference does teach, as well as what it does not. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), *Manual of Patent Examining Procedure* § 2141 et seq.

In the present case, the Examiner vacillates between what the Cukor reference does teach and what it does not. This is a switching of the Cukor from being used as a 35 U.S.C. § 102 reference and a 35 U.S.C. § 103 reference. Since the Examiner alters his position on what he believes to be within Cukor's teaching, it follows that the Examiner is changing the basis of the rejection in that the Examiner alters the scope of the Cukor reference and thereby its applicability under both 35 U.S.C. §§ 102 and 103.

In addition to creating new grounds of rejection from one Office Action to another, the examiner alters his position within individual Office Actions so as to render it impossible for Appellant to determine if Cukor is being used as a 102 reference with respect to the limitations pertaining to "messages" and "completed inquiries" or a 103 reference. More specifically, in the Final Rejection on page 6, lines 8-9 the Examiner first asserts that "Cukor further discloses means for storing messages and completed inquiries (Col. 14 -27)" and then asserts an opposite contention on page 6, lines 12-14

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when he states "it would have been obvious to one of ordinary skill in the art of financial information management to include means for storing customer messages and inquiries." The Examiner repeats this inconsistent use of Cukor as a 102 or 103 reference for these claim limitations in the Examiner's Answer when he states on page 7, lines 6-7 that "it would have been obvious to one of ordinary skill in the art of financial information management to include means for storing customer messages and inquiries" but changes his interpretation of Cukor on page 8, lines 9-12 when he asserts "Cukor discloses . . . (3) messages at col. 21, lines 13-20; and (4) completed inquiries at Col. 21, lines 15-27." Thus, within individual Office Actions, the Examiner's chameleon-like use of what Cukor does and does not teach renders it impossible for appellant to formulate a proper response.

For these reasons, it is respectfully submitted that the Examiner has changed his grounds of rejection during prosecution of the present application and has thus entered a new ground of rejection in the Examiner's Answer in contravention of 37 C.F.R. § 1.193(a)(2). Thus, the Commissioner is respectfully requested to reopen prosecution and allow appellant to respond to this new ground of rejection pursuant to 37 C.F.R. 1.193(b)(2)(ii).

Respectfully submitted,

Michael F. QUINN et al.

Date: 3/4/99

By:

George T. Marcou
Registration No. 33,014

KILPATRICK STOCKTON LLP
Suite 800
700 13th Street, N.W.
Washington, D.C. 20005
(202) 508-5800

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On March 4, 1999

KILPATRICK STOCKTON LLP
700 13th Street, N.W., Suite 800
Washington, D.C. 20005

By: Amelia C. Costa

Date: March 4, 1999

03/04/99 15:23 FAX 202 508 5858

KILPATRICK STOCKTON LLP

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KILPATRICK STOCKTON LLP

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Official

Attorneys at Law
Suite 800
700 Thirteenth Street, N.W.
Washington, D.C. 20005
Telephone: 202.508.5800
Facsimile: 202.508.5858
Web site: www.kilstock.com

E-mail: gmarcon@kilstock.com
Direct Dial: 202.508.5846

March 4, 1999

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George T. Marcon
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